

Application No.: 10/748739

Case No.: 59491US002

REMARKS

Reconsideration of the application is requested.

Claim Status

Claims 1 to 5 are pending. No claims are currently canceled, withdrawn from consideration, amended, or added.

§103 Rejection

Claims 1-5 were rejected under 35 U.S.C. §103 over U.S. Patent No. 5,569,696 (Abramson et al.) in view of PCT Application No. 2003/082,997 (Fan PCT).

There are numerous distinctions between each of those references, the proposed combination, and the present invention.

First, primary reference Abramson et al. relates to cementitious grout whereas the present invention concerns polymeric grout. See, for example, col. 1, line 24, col. 2, lines 30-31 (where it distinguishes the Abramson et al. invention from "existing cement grouts", and col. 3, line 42.

The urethane component in the present invention is a fluorocarbon urethane whereas the urethane component disclosed in Abramson et al. is hydrocarbon, i.e., not fluorine-containing. Furthermore, the urethane component in Abramson et al. is fully reacted, see, e.g., col. 2, line 33, whereas the fluorocarbon urethane component of the present invention, i.e., with a functional silane group is reactive.

Secondary reference Fan et al. does not cure these deficiencies. The reference does not disclose use of the protective materials disclosed therein on polymeric grouts; the only grout materials are cementitious grout materials. Moreover, the reference does not disclose the incorporation of protective material into a grout composition to impart protective performance thereto.

There is no basis which would lead one skilled in the art to make the proposed combination of references, and even if such combination is assumed, the present invention is not suggested or disclosed.

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For these reasons, Applicants respectfully submit that the rejection under 35 USC §103 has been overcome and should be withdrawn.

Double Patenting

Claims 1-5 were rejected for obviousness-type double patenting over claims 1-34 of U.S. Patent No. 6,646,088 (Fan) and provisionally rejected for obviousness-type double patenting over claims 24-27 of copending U.S. Application No. 10/957,355.

A freshly signed terminal disclaimer over U.S. Patent No. 6,646,088 (Fan et al.) is enclosed. Applicants respectfully submit that this renders moot the rejection for obviousness-type double patenting over this reference. The undersigned apologizes for any inconvenience caused by inadvertent failure to enclose a signed disclaimer with the last response.

Copending U.S. Application No. 10/957,355 is not yet issued, accordingly Applicants respectfully request that the provisional rejection for obviousness-type double patenting threcover be withdrawn.

CONCLUSION

In view of the above, it is submitted that the application is in condition for allowance.

Respectfully submitted,

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